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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,484	02/04/2002	Bob B. Buchanan	416272000200	7171
20872	7590	08/23/2005	EXAMINER	
MORRISON & FOERSTER LLP 425 MARKET STREET SAN FRANCISCO, CA 94105-2482			NOLAN, PATRICK J	
			ART UNIT	PAPER NUMBER

1644

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/067,484

**Applicant(s)**

BUCHANAN ET AL.

**Examiner**

Patrick J. Nolan

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 14, 16-18, 22-24, 32-35 and 47-51 is/are pending in the application.  
4a) Of the above claim(s) 47, 49 and 50 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-3, 14, 16-18, 22-24, 32-35, 48 and 51 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

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1. Claims 1-3, 14, 16-18, 22-24, 32-35 and newly added claims 47-51 are pending.
2. Newly submitted claims 47 and 49-50 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: fusion proteins are classified separately from proteins themselves (424/192.1 versus 424/275.1) and as such would require a patentably distinct search.
3. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 47 and 49-50 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.
4. The claims being examined consonant with the original election are 1-3, 14, 16-18, 22-24, 32-35, 48 and 51.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 14, 16-18, 22-24 and newly added claims 48 and 51 are rejected under 35 U.S.C. 102(a) or (b) as being anticipated by Del Val et al. (Reference 6 on the IDS submitted 2/3/03), of record, for reasons supplied in the Office Action mailed 3-1-05.

Applicant's arguments and 37 CFR 1.132 declaration filed 6-7-05 have been fully considered but are not found persuasive.

Applicant argues the 102(b) rejection should be removed since they have provided a stamp date from Stanford Medical Library indicating when the abstract book was received by the library, thereby obviating the 102(b) rejection.

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However, this does not provide evidence as to when the abstract book was first made publicly available. In order to establish this, Applicant could do one of two things, provide a letter from the publisher of the abstract book indicating when the abstract was first made publicly available, or a declaration by Applicant, since they received the abstract book, as to when they first received it.

The 102(a) rejection is maintained because the 37 CFR 1.132 declaration was insufficient because it did not explain the role of Suzanne Tuebers, who was an author but not an inventor.

The following new ground of rejection is necessitated by Applicant's amendment filed 6-7-05.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 32-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Del Val et al., (Reference 6 on the IDS submitted 2/3/03) in view of US Patent No. 4,281,061.

The Del Val et al., has been discussed previously. In addition, Del Val et al., teaches performing an immunoassay to detect IgE in patients sensitive to ragweed allergens.

The claimed invention differs from the prior art teachings only by the recitation of putting said immunoassay components in a kit with instructions.

However, the '061 patent teaches that reagents for an immunoassay can be provided as kits as a matter of convenience and to optimize the sensitivity of the assay in the range of interest (col 22, line 62 - col 23, line 4).

Therefore it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to be motivated to place the immunoassay components, taught by the '347 patent in a kit as taught by the '061 patent for a matter of convenience. Further it would have been obvious to place instructions in said kit as said instructions are standard in the assay art.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.


10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Nolan whose telephone number is 571-272-0847.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Christina Chan, can be reached at 571-272-0841.

  
Patrick J. Nolan, Ph.D.

Primary Examiner, Group 1640

August 19, 2005